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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,165	02/07/2001	Marc Husemann	Beiersdorf 707	1836

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EXAMINER

BERMAN, SUSAN W

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/778,165

Applicant(s)

HUSEMANN ET AL. *PL*

Examiner

Susan W Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

The amendments to claims 3-6 overcome the rejections under 35 USC 112 set forth in paper number 7 by setting forth that the polymer is first protected by introduction of tert-butoxycarbonyl groups and that deprotection with a polymerization regulating photoinitiator takes place before crosslinking.

Response to Arguments

The rejection of claims 1, 2, 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, is withdrawn in response to applicant's argument for reconsideration. Applicant's argument that the total weight upon which the recited weight percents is based on the total weight of the polymer mixture comprising components a, b, c as set forth in claim 1 is persuasive and the rejection under 35 USC 112, second paragraph is withdrawn.

Applicant argues that the word "obtainable" is employed in patented claims. However, this observation does not negate that the instant claims fail to require that the claimed "polyacrylate" is one obtained by thermal crosslinking of the monomers set forth in "a)", a polymerization regulating photoinitiator "b)" and a difunctional isocyanate and/or bifunctional epoxide "d)". The term "obtainable" requires only that the polyacrylate can be obtained by the method and from the components set forth; the term does not require that the recited method or components be employed. Thus polyacrylates other than polyacrylates obtained by thermal crosslinking of the monomers set forth in "a)", a polymerization regulating photoinitiator "b)" and a difunctional isocyanate and/or bifunctional epoxide "d)" are encompassed by the claim language.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-8, 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the word "obtainable" in claim 1 renders the claims indefinite because the claimed polyacrylate is not limited to a polyacrylate obtained by the thermal crosslinking of the composition set forth. The claim, as written, reads on any known polyacrylate obtained by any method known in the art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following rejections are based on the claim 1 language "polyacrylate obtainable by thermal crosslinking..." which, as discussed above, does not limit the claimed polyacrylate to a polyacrylate obtained by thermal crosslinking of the components set forth in claim 1.

Claims 1, 2, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by massow et al (5,194,455). Massow et al disclose a polyacrylate obtained by polymerizing an acrylic monomer with N-tert.-butylacrylamide and, optionally, additional ethylenically unsaturated compounds, to provide a pressure sensitive hot melt adhesive.

Claims 1, 2, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Ushirogouchi et al (6,045,968). Ushirogouchi et al disclose polyacrylates obtained from(meth)acrylate compounds

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containing tert-butoxy groups that are crosslinked with naphthol novolak compounds in the presence of photo-generating agents. See columns 20-22.

Claims 1, 2, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Skinner et al (4,128,600). Skinner et al disclose interpenetrating dual cure resins comprising a polyacrylate having hydroxy functional groups, a polyisocyanate and a photoinitiator that forms a urethane linked copolymer. See the Examples.

Claims 1, 2, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Karim et al (5,721,289). Karim et al discloses products obtained by crosslinking compositions comprising a polyacrylate and a cationically polymerizable monomer in the presence of a photoinitiator. See column 5, lines 49-53, column 6, lines 7-63, column 7, lines 4-10, column 15, lines 19-35, and Examples 2-9.

Claims 1, 2, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wesp (3,765,972). Wesp discloses adhesive compositions comprising a film-forming latex, which can be a polyacrylate containing hydroxyl groups crosslinked with a transient tackifier comprising an epoxy resin. The latex can preferably be an acrylic ester-hydroxyl functional monomer copolymer (column 6, line 61, to column 7, line 19). See Example 3.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wesp (3,765,972). Wesp discloses adhesive compositions comprising a film-forming latex and a transient

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tackifier comprising an epoxy resin and a curing agent, such as an amine. The latex can preferably be an acrylic ester-hydroxyl functional monomer copolymer (column 6, line 61, to column 7, line 19). See column 13, lines 36-53 and Example 3. Wesp does not mention adding a photoinitiator.

It would have been obvious to one skilled in the art to employ the compositions disclosed by Wesp to obtain a polyacrylate by thermal crosslinking without addition of a photoinitiator since there are no protected hydroxyl groups to be deprotected. See the rejection of claims 1, 2, 9 and 10 under 35 USC 112, first paragraph set forth above. Claims 1, 2, 9 and 10 encompass compositions wherein the (meth)acrylate "a3" contains hydroxyl groups and no tert-butoxycarbonyl groups.

Allowable Subject Matter

Claims 3-8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 703 308 0040. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703 308 2462.

The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9310 for regular communications and 703 872 9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.



Susan W Berman
Primary Examiner
Art Unit 1711

SB
1/28/03